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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,670	06/29/2000	Young Soul Park	03060039AA	8557

30743 7590 05/07/2003

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[REDACTED] EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
3728	[REDACTED]

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/582,670	PARK, YOUNG SOUL
	<b>Examiner</b>	<b>Art Unit</b>
	Ted Kavanaugh	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 April 2003.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
  - 4a) Of the above claim(s) 1-4,8 and 9 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5-7,10 and 11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____                                    |

***Election/Restrictions***

1. Applicant's election with traverse of group III (claims 5-11) and species L (Figure 22) in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the Examiner has not made any demonstration of distinctness of inventions and the all of the groups share the same corresponding special technical feature. This is not found persuasive because as noted in the rejection of the claims below, the claims don't share a corresponding special technical feature. Regarding the lack of demonstration of distinctness of inventions, for a showing of lack of Unity a showing of distinctness of inventions is not required. All you deal with in a 371 case is Lack of Unity, and same or corresponding special technical feature. You do not deal with distinct inventions. The elected claims have been rejected (see the action below), that conclusively show that there are no common or corresponding special technical features, because there are no special technical features at all. See PCT Rule 13.2 and Annex B to the Administrative Instructions Under the PCT.

Regarding applicant's arguments about a burden, this is not persuasive because while some aspects of the inventions may overlap the search would be burdensome and longer because the examiner would need to search for all of the distinct inventions or variations. Furthermore, the search is only part of the examination process, the MPEP 803 states "If the search and examination of an entire application ..." (underline added) can be made without serious burden". The examination of the application would be burdensome because the examiner would be required to apply art and rejections to all of the distinct and different species of invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-4,8 and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

***Claim Rejections - 35 USC § 112***

3. Claims 5-7,10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, the following terms "the throughout holes", "front edge", "back edge", and "midsole" lack proper antecedent basis and therefore are unclear and indefinite. The phrase "passing through front edge and back edge in side direction of midsole formed in a shooting molding" is not understood and therefore is unclear and indefinite. The holes extend from one side of the sole to the other side and not from the front edge to the back edge. Also, what is the "side direction of midsole". Also, what is formed in a shooting molding"?

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5-7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4753021 (Cohen).

Cohen teaches an outsole (12,14,16) substantially as claimed including midsole (14) with throughout holes (the throughout holes are formed between the ribs 18 which can extend the entire width of the shoe, see col. 2, lines 37-39), a vertical support (ribs 18 and/or 22 and/or 26), stoppers ("solid plugs, col. 5, line 57), and elastic plates or elastic bars (94; see figure 16).

6. Claims 5-7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5577334 (Park).

Park teaches an outsole substantially as claimed including midsole with throughout holes (2,6,11), a vertical support (the supports between the throughout holes), stoppers (a filler, see col. 3, lines 1-3), and elastic plates or elastic bars (10).

7. Claims 5,6 and 11are rejected under 35 U.S.C. 102(b) as being anticipated by US 5461800 (Luthi et al).

Luthi teaches an outsole (54,10) substantially as claimed including midsole (10) with throughout holes (tubes), a vertical support (the support at the arch region between throughout holes), and erect protrusions (56).

### ***Conclusion***

**Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.**

8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to **(703) 872-9303 (FORMAL FAXES ONLY)**. If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov .

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282

Art Unit: 3728

Terminal Disclaimers

(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line  
Internet PTO-Home Page

1-800-786-9199  
<http://www.uspto.gov/>



Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK

May 1, 2003